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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 10/612,363 | 07/02/2003 | Christopher J. Hess | 14834Z (ETH1540-CONT) | 5400 |

23389 7590 03/08/2006

SCULLY SCOTT MURPHY & PRESSER, PC
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EXAMINER

ROANE, AARON F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/612,363 | Applicant(s) HESS ET AL. | |
| | Examiner Aaron Roane | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Abele et al. (USPN 5,190,541).

Regarding claims 18 and 21, Abele et al. disclose surgical device for severing tissue, the surgical device comprising: a shaft (12) having a proximal end and a distal end; a hook member (42 and 16 collectively) at the distal end of the shaft, the hook member configured to capture a vessel, a plunger or sliding member (both elements labeled 54, collectively) movable with respect to the hook member from a first position to a second position and having a movable cutting blade (distal end of 56) housed therein, where the captured vessel is situated between the hook member and the cutting blade; and at least one electrode (distal ends of 54) separate from the hook member and the cutting blade for applying RF energy to cauterize the captured vessel, see col. 3-6 and figures 1-7.

Regarding claim 19, Abele et al. further disclose the at least one electrode is two electrodes (the two distinct distal ends of the first and second 54) separated by a dielectric (the two thin sections of 12 located between the two 54's and 56, see figure 4 and col. 5, lines 33-58).

Regarding claim 20, Abele et al. further disclose the hook member is at least partially slidingly disposed within the shaft, see co. 3-6 and figures 1-7.

Response to Arguments

Applicant's arguments filed 12/05/2006 have been fully considered but they are not persuasive. The examiner will address each argument/remark in turn.

On page 3, 3rd paragraph of the response Applicant asserts that Abele et al. do not “teach and every element of the claimed invention” and therefore can not reject the presently claimed invention under 35 U.S.C. 102(b). Applicant then goes on to summarize the Abele et al. patent. However, the examiner strongly disagrees with Applicant's assertion that Abele et al. do not “teach and every element of the claimed invention.”

In the last two lines of page 3 through the 1st line of page 4, Applicant asserts “the sealing clamp bars 54 and the electrosurgical knife 56 are movable in unison by a shaft 72 connected to the control section (col. 4, lines 39-45 and 57-60).” The examiner has read the cited passages and though Applicant may interpret Abele et al. as disclosing this unison movement the

examiner finds nothing to suggest that the clamp bars 54 and the electrosurgical knife 56 are stationary with respect to each other. As a matter of fact, the notion of the clamp bars 54 and the electrosurgical knife 56 being fixed with respect to each other is counter to the intended use and functionality of the Abele et al. device. Furthermore, it can be appreciated that the clamp bars 54 and the electrosurgical knife 56 are slidable with respect to each other by viewing figures 5a, 5b and 5c.

Next, Applicant asserts on page 4, lines 1-3 “the knife 56 of Abele is not housed within a movable sliding member having a cutting blade therein as recited in Applicants' claim 18, nor is the knife 56 of Abele slidably disposed within a plunger as recited in Applicants' claim 21.”

Already, we have seen that the clamp bars 54 (i.e., plunger or sliding member) and the electrosurgical knife 56 are slidable with respect to each other. The plunger or sliding member or more specifically the system or collection of the clamping bars do shelter, accommodate and/or provide a space for the cutting blade as is evident in the above noted figures. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

This action is FINAL.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

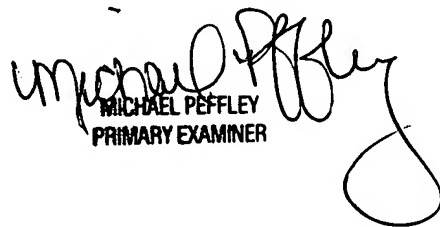
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *AR.*
February 27, 2006


MICHAEL PEFFLEY
PRIMARY EXAMINER